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Patent
Attorney's Docket No. 001560-308

10-3-98

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
ASHIKARI et al.) Group Art Unit: 1649
Application No.: 08/894,356) Examiner: U. Zaghmount
Filed: August 18, 1997)
For: GENE ENCODING A PROTEIN)
HAVING ACYL GROUP)
TRANSFER ACTIVITY)

REPLY TO RESTRICTION REQUIREMENT AND PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Prior to examination on the merits, please amend the above-identified application as follows:

IN THE CLAIMS:

In claim 5, page 74, line 21, please delete "as set forth in" and insert --of--.

In claim 6, page 74, line 27, please delete "in".

REMARKS

Entry of the foregoing is respectfully requested. On page 2 of applicants preliminary amendment, a typographical error was made on line 8. Specifically, "In line 15" should be "In claim 5." In order to clarify this amendment, applicants have now amended claim 5 as was originally intended. Furthermore, claim 6 has been further amended in order to clarify the invention.

RESTRICTION REQUIREMENT

In response to the official action dated September 22, 1998, applicants hereby respond as follows.

The Examiner required that the present application be restricted, under 35 U.S.C. § 121, to one of the following three groups:

Group I. Claims 1-12, 20, and 22-27, drawn to a nucleic acid molecule encoding acyl group transfer protein, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in Class 800, subclass 278.

Group II. Claims 13-18 and 24, drawn to a method for acylating a pigment, classified in class 530, subclass 300.

Group III. Claims 19, 21 and 24, drawn to a method for acylating a pigment, classified in class 530, subclass 300.

1. *Election*

Applicants hereby elect, with traversal, the invention defined by the Examiner as Group I, claims 1-12, 20, and 22-27, drawn to a nucleic acid molecule encoding acyl group transfer protein, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in Class 800, subclass 278.

2. *The Restriction Requirement Can Be Withdrawn*

The Examiner provided a number of reasons to justify the restriction requirement. For example, the Examiner has characterized the claims of the three Groups as

molecularly, physiologically, and biochemically divergent products and processes not required by the other.

Applicants respectfully traverse the restriction requirement. Applicants submit that the Examiner has applied the M.P.E.P. § 803 standard of restriction practice to the present application. Applicants contend that it is improper to apply the M.P.E.P. § 803 standard of restriction practice to the present application. The present application is an international application in the national stage and has been filed under 35 U.S.C. § 371. According to M.P.E.P. § 1893.03(d), the unity of invention standard of practice should be applied to an international application in the national stage which has been filed under 35 U.S.C. § 371. Thus, the unity of invention standard of practice should be applied to the present application.

Applicants submit that the Examiner has failed to apply the unity of invention standard of analysis to the present application. Under this standard, the Examiner is required to (1) list the various groups of claims and (2) explain why each group lacks unity with each of the other groups (i.e., why there is not single inventive concept), specifically describing the unique special technical feature in each group. M.P.E.P. § 1893.03(d). Applicants contend that the Examiner has failed to explain why the claims in Groups I-III lack unity of invention.

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. M.P.E.P. § 1893.03(d). If an

application contains more than one invention, applicants have the right to include in a single application those inventions which are so linked as to form a single general inventive concept. Further, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The special technical feature is what defines the contribution which each claimed invention, considered as a whole, makes over the prior art. M.P.E.P. § 1893.03(d). Applicants submit that the technical features which form the special technical relationship among the inventions of the present application are the nucleic acids of the claims of Group I.

Several examples, which illustrate the principles of unity of invention, are found in Appendix AI of the M.P.E.P. (see the PCT Administrative Instructions, Annex B, Part 2). Examples 1 (at M.P.E.P. page AI-42) and 17 (at M.P.E.P. page AI-46) are particularly relevant to the present application.

Example 17 illustrates that unity exists between a protein and the DNA sequence encoding that protein. Example 17 corresponds to the relationship between the nucleic acids of the claims of Group I and the proteins of the claims of Group II, which these nucleic acids encode. Thus, unity of invention exists between the claims of Groups I and II. Accordingly, the claims of Groups I and II should be examined together.

Example 1 illustrates that unity exists between a substance and the use of the substance for some purpose. This example corresponds to the relationship between the nucleic acids of the claims of Group I and the methods of the claims of Group III. Thus,

unity of invention exists between the claims of Groups I and III. Accordingly, the claims of Groups I and III should be examined together.

Because unity of invention exists between the claims of Groups I and II, unity of invention also exists between the claims of Group I and the claims of Group III, which share unity of invention with the claims of Group II. Accordingly, applicants submit that each of claims 1-27 should be examined together.

CONCLUSION

Applicants submit that the restriction requirement is improper. The special technical features of the present application simultaneously provide unity of invention and preclude the restriction of the claims. Accordingly, applicants respectfully request that this restriction requirement be withdrawn and that claims 1-27 be examined together.


Early and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

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In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Donna M. Meuth
Registration No. 36,607

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

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